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3-13-07

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In re application of
Kimio Inoue
Serial No. 09/767,885
Filed: January 24, 2001
For: Screw Set for Extruder

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: DECISION
: DENYING
: PETITION
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This is a decision on the REPLY TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF/PETITION UNDER 37 CFR 1.181, filed on February 2, 2007.

An appeal brief was timely filed October 25, 2006, appealing the examiner's final rejection of claims 10-13, claim 10 being the sole independent claim. On January 23, 2007, the examiner issued a Notification of Non-Compliant Appeal Brief (37 CFR 41.37), which held the brief to be defective for (1) failing to refer to the independent claim by number; and (2) including arguments within the 'grounds of rejection to be reviewed on appeal' section.

On February 2, 2007, the instant petition was timely filed and is before the Director of Technology Center 1700 for consideration. The petition requests withdrawal of the Notification of Non-Compliant Appeal Brief.

The petition is **DENIED** for the reasons below.

DECISION

Petitioner argues that there is no requirement in 37 CFR 41.37 that the summary of the claimed subject matter refer to the independent claims by number, and further that there is only one independent claim on appeal in this case, so claim numbers are not required for clarity.

In general, the summary section should refer to the claims by number for clarity, so that the Board of Patent Appeals and Interferences can readily identify the claims being discussed. This is particularly true since dependent claims may also be addressed in the summary. However, as noted by petitioner, only one independent claim is on appeal in this case, and were this the only issue, the brief would not be held defective.

Petitioner likewise argues that 37 CFR 41.37 does not prohibit including arguments in the description of the grounds of rejection to be reviewed. However, 37 CFR 41.37(b)(1)(vi) requires a *concise* statement of each ground of rejection presented for review. MPEP 1205.02 expounds upon this as follows:

(vi) Grounds of rejection to be reviewed on appeal. A concise statement of each ground of rejection presented for review. For example, the statement "Whether claims 1 and 2 are unpatentable" would not comply with the rule, while the statements "Whether claims 1 and 2 are unpatentable under 35 U.S.C. 103 over Smith in view of Jones," and "Whether claims 1 and 2 are unpatentable under 35 U.S.C. 112, first paragraph, as being based on a nonenabling disclosure" would comply with the rule. The statement cannot include any argument concerning the merits of the ground of rejection presented for review. Arguments should be included in the "Argument" section of the brief.

In the instant case, the grounds section impermissibly includes five lines of argument, which should properly be located in the argument section of the brief. Thus the statement is not concise and the determination that the Brief was defective under 37 CFR 41.37 was correct.

Applicant's petition is therefore **DENIED**.

A corrected brief is due within the time period specified on the Notice of Non-Compliant Appeal Brief.



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